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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,323	06/26/2000	Fang Sun	1179/2/2	3143
29739	7590	08/24/2006	EXAMINER	
SMITH MOORE LLP			NUTTER, NATHAN M	
P.O. BOX 21927			ART UNIT	
GREENSBORO, NC 27420			PAPER NUMBER	

1711

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,323

Applicant(s)

SUN ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-00</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 20 January 2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Contrary to Applicant's assertions, there are nine (9) documents written in Japanese with no accompanying "concise explanation" of their relevance.

Further, the examiner would like to point out that it has been held in the courts that the "applicant has [an] obligation to call the most pertinent prior patent to [the] attention of [the] Patent Office in a proper fashion." [*Penn Yan Boats, Inc. V. Sea Lark Boats, Inc., et al.* 175 USPQ 260 (DC SFla 1972)]. The examiner would appreciate the applicant identifying why the cited reference is pertinent including relevant portions of the document cited.

With regards to the requests for copies of initialed Information Disclosure Statements, as recounted in the Response of 3 July 2006, the Supplemental Information Disclosure Statement of 18 October 2000 has already been considered by Examiner Rajguru, copy enclosed, there are no eDan records of any Third Information Disclosure Statement of 16 October 2000, nor of the Fourth Information Disclosure Statement of 15 December 2000.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 20-22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Woodrum (US 5,997,690).

The reference to Woodrum teaches the production of a web by a wet-laid process that includes an ion sensitive super absorbent polymer (SAP), fibers, and a salt dissolved in the water carrier. Note the Abstract and column 2 (lines 46-67). At column 3 (lines 1-13) the reference teaches the polymer as being particulate upon impregnation onto the web, and ion-sensitive, i.e. pre-super absorbent. Note the paragraph bridging column 3 to column 4 for the neutralization of the polymer. The SAP is discussed in depth at column 6 (line 27) to column 7 (line 26), including the surface cross-linking thereof.

The reference teaches essentially what is recited and claimed herein except with reference to the concept of pre-SAP. The constituents are identically disclosed and employed in identical capacities. Other than a matter of nomenclature, the reference is deemed render the claims at least obvious, if not anticipated.

Response to Arguments

Applicant's arguments filed 3 July 2006 have been fully considered but they are not persuasive.

Prior, Applicants have alleged, yet failed to show, differences of the instant claims over the reference to Woodrum (US 5,997,690). Both the reference and the instant claims require a wet-laid web. Applicants allege that "Woodrum fails to disclose a water sorptive product including a pre-superabsorbent and a neutralizing agent as set forth in the present claims." This is not so since the reference is clear that a superabsorbent in particulate form is employed, just as recited herein. The neutralizing agent is employed, as well, being the salts disclosed at the paragraph bridging column 3 to column 4, including sodium carbonate, which is disclosed in the instant Specification at the paragraph bridging page 8 to page 9. The identical effect would be realized using the teachings of Woodrum as herein since the same constituents are employed. The order of addition of the constituents, since all are added for the identical reasons to a composition that is identically produced otherwise, is not deemed to be critical, nor has such been shown by applicants. Applicants further allege that "(n)ot only does Woodrum fail to teach a water sorbtive (sic) product including a neutralizing agent, Woodrum at

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column 4, lines 2-5, teaches including a salt such as sodium sulfate since carbonates have the effect of further neutralizing the SAP. Based on this, Woodrum would teach away from including a neutralizing agent, as required by the present invention." This is not deemed to be precise nor convincing. The reference says "preferred salt" and still includes the carbonates within the definition of suitable neutralizing agents. A reference is taken for the entirety of its teachings, not for any isolated passage used to assert patentability. Further, depending on the degree of neutralization desired, a skilled artisan would know to what level the neutralizing salt might be employed suitably.

Further, as of 3 July 2006, applicants contend that the "paragraph bridging columns 3 and 4 does not disclose neutralization of the superabsorbent polymer but discloses "[t]he preferred salt is sodium sulfate because chloride salts contribute to metal stress cracking, and carbonates have the effect of further neutralizing the SAP." Clearly, by this, Woodrum teaches one does not use a neutralizing agent in the water slurry." Applicants words ring hollow since applicants attempt to distort and mis-characterize the full teaching of that passage even as they attempt to differentiate using same. The passage clearly says "(t)he preferred salt is sodium sulfate because... carbonates have the effect of further neutralizing the SAP," which is essentially the concept herein. Carbonates are disclosed as being usable, and will neutralize, as argued by applicants for their own composition. A reference is viewed for the entirety of its teachings, not for isolated phrases that might lend relevance to their otherwise erroneous arguments. Further, applicants have failed to show why the water sorptive composition of Woodrum (swells with the addition of water)). Finally, applicants contend

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the SAP of Woodrum is not a pre-SAP, which is merely the SAP before neutralization.

This is not so in view of patentee's disclosure at column 6 (lines 27 et seq.) which clearly recite polymers that are not neutralized, as well as neutralized and partially-neutralized. Choice of the pre-SAP definition polymers is within the skill of the art, and is shown by the reference itself. Applicants conclusions are based on reasoning using only selected passages, and interpretation of passages out-of-context, while ignoring the totality of the reference's teachings. It is further pointed out that the rejection was made under 35 USC 102 and 35 USC 103, not under 35 USC 102, as apparently the reasoning is being argued.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

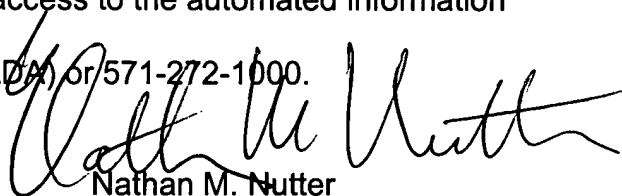
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
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nmn

20 August 2006